

REMARKS

This amendment is in response to the Office Action mailed January 27, 2009.

Reconsideration of this application is respectfully requested, in view of the foregoing amendments and accompanying remarks.

I. Status of the Claims

After entry of this amendment, claims 1-11, 13-16, 18 and 25 are pending. Claims 1, 11, 15 and 16 are amended.

Claim 1 is amended to delete compounds in which R³ and R⁴ are linked together to form a pyridyl group. Dependent claim 11 is amended accordingly. Dependent species claim 15 is amended to delete species no longer covered by claim 1 as amended.

Dependent claim 12 is canceled.

Claim 1 is also amended to overcome rejections under 35 U.S.C. § 112, second paragraph, as requested by the Examiner.

Claim 16 is amended to recite a "pharmaceutically acceptable" inert carrier.

II. Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 1, 15 and 16 stand rejected under 35 U.S.C. §112, second paragraph, as indefinite. In response, the claims are amended as requested by the Examiner. Claim 1 is amended to delete the term "as well as," to correct the spelling of "with one or more of" and to recite "or a pharmaceutically acceptable salt thereof." Pharmaceutical composition claim 16 is also amended to recite a "pharmaceutically acceptable" inert carrier.

Applicants traverse the Examiner's request that pharmaceutical composition claim 16 be amended to recite an "effective amount" of the compound of claim 1. It is believed that the claim is not indefinite as written. A claim is not indefinite when "one skilled in the art would understand the bounds of the claim when read in light of the specification." *Kinetic Concepts Inc. v. Blue Sky Medical Group Inc.*, 554 F.3d 1010, 89 U.S.P.Q. 2d 1801, 1808 (Fed. Cir. 2009) (quoting *Personalized Media Comm. v. ITC*, 161 F.3d 696, 705, 408 U.S.P.Q. 2d 1880 (Fed. Cir. 1998)). It is not seen how the claims are indefinite to one skilled in the art.

Further, pharmaceutical compositions are commonly manufactured in various dosage amounts. Depending on the patient and disease condition the dosage of one composition may not be "effective."

In view of the action taken and arguments made, it is believed that the rejection under 35 U.S.C. §112 has been overcome, and it is respectfully requested that the rejection be withdrawn.

III. Rejections Under 35 U.S.C. §102

Claims 1-3, 9, 11, 12 and 16 stand rejected under 35 U.S.C. § 102(b) as anticipated by WO 02/30930. The Examiner cites Examples 152-156 and 182, in which the substituents corresponding to R³ and R⁴ in formula (I) are linked to form a pyridyl group.

In response, claim 1 is amended to delete compounds in which R³ and R⁴ are linked together to form a pyridyl group. Species claim 15 is amended to delete species no longer covered by amended claim 1. The claims as amended are not anticipated by Examples 152-156 and 182 of WO '930.

In view of the action taken and arguments made, it is believed that the rejection under 35 U.S.C. §102 has been overcome, and it is respectfully requested that the rejection be withdrawn.

IV. Conclusion

In view of the action taken, it is believed that all pending claims are not indefinite, and are not anticipated by the cited art. It is believed that all pending claims are now in condition for allowance.

Favorable action is earnestly solicited.

Respectfully submitted,

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